

REMARKS

In the Office Action, The Examiner rejected claim 44 under 35 U.S.C. §101; rejected claims 1, 2, 10, 26, 28, 32, 37, 40, 43, and 44 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,128,279 to O'Neil in view of U.S. Patent No. 6,421,321 B1 to Sakagawa et al. (Sakagawa); rejected claims 3 and 5 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and U.S. Patent No. 6,678,735 to Orton et al. (Orton); rejected claim 4 under 35 U.S.C. §103(a) as unpatentable over O'Neil in view of Sakagawa, Orton, and E.P. 1,089,515 to Morrow; rejected claims 6-9, 12, 13, and 35 under 35 U.S.C. §103(a) as unpatentable O'Neil, Sakagawa, and U.S. Patent No. 5,914,953 to Krause; rejected claims 11, 27, 29-31, 33, 34, and 42 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and Morrow; rejected claims 14, 16-23, and 38 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and U.S. Patent Application Publication No. 2004/0057449 to Black; rejected claims 15 and 24 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, Black, and Morrow; rejected claims 25 and 41 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and U.S. Patent No. 6,115,361 to Fredericks et al. (Fredericks); rejected claim 36 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, Krause, and Orton; rejected claim 39 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, Black and Morrow

By this amendment, Applicants amend claims 1, 2, 8, 18, 35, 37, and 44 to more clearly define the features of those claims. Applicants also cancel claims 16, 19-22, 25, 36, and 41, without prejudice or disclaimer.

Claims 1-15, 17, 18, 23-35, and 37-44 are pending.

Regarding the rejection of claim 44 under 35 U.S.C. §101, Applicants have

amended claim 44 (adding “non-transitory”) to obviate the basis of the rejection. Thus, the rejection of claim 44 under 35 U.S.C. §101 should be withdrawn.

The Examiner rejected claims 1, 2, 10, 26, 28, 32, 37, 40, 43, and 44 under 35 U.S.C. §103(a) as unpatentable over O'Neil and Sakagawa. Applicants respectfully traverse this rejection.

For a proper rejection under 35 U.S.C. §103(a), the Office “bears the initial burden of factually supporting any prima facie conclusion of obviousness” and must therefore present “a clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. §2142. An obviousness rejection “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” M.P.E.P. §2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. M.P.E.P. §2141.02 further notes that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The rejection of the currently pending claims fails to satisfy this burden.

Claim 1 recites, among other things, the following feature: “setting a load control information in a predetermined field of a layer three or above message, wherein the

load control information is separate from addressing information for said message.”

Claim 1 also recites “routing said message in a packet data network” and “checking said load control information on the routing path of said message.” Moreover, claim 1 recites “selecting a processing resource of said packet data network in response to the result of said checking of said load control information.”

The Examiner alleges that O’Neil at column 4, lines 1-9, 22-36, col. 57, line 57-column 8, line 37, and FIGs. 1 and 3. Applicants disagree and submit that a careful scrutiny reveals that O’Neil does not disclose what the Examiner alleges. Instead, O’Neil discloses the use of a uniform resource locator to limit processing by a server to a given “type.” O’Neil at column 4, line 5. In any case, the URI is not used in connection with load control. Nor is the URI or the corresponding message checked for load control information. Rather than check the URI or the corresponding message, O’Neil instead directly checks the server to see what load is currently being handled by the server. See O’Neil at column 4, lines 1-9 and FIG. 2A (reproduced below). Thus it would be a *clear error* to allege that O’Neil’s URI constitutes “load control information,” much less “setting a load control information in a predetermined field of a layer three or above message, wherein the load control information is separate from addressing information for said message.”¹

To cure the noted chasm in O’Neil, the Examiner relies on Sakagawa. Although Sakagawa discloses a shortcut path message to establish a shortcut path, Sakagawa

¹ See *In re Suitco Surface, Inc.* (Fed. Cir. 2010) (finding that the PTO’s practice of giving a claim the broadest, reasonable construction “does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent).”

fails to cure the aforementioned deficiencies of O'Neil. Therefore, claim 1 is allowable over O'Neil and Sakagawa, whether taken alone or in combination. And, the rejection under 35 U.S.C. § 103(a) of claim 1, as well as claims 2 and 10 at least by reason of their dependency from independent claim 1, should be withdrawn.

Regarding claim 2, it recites "wherein said predetermined field is a subfield of a user part of said message, wherein the load control information provides information to enable load balancing to substantially equalize the load among nodes of an internet protocol multimedia subsystem of a public land mobile network." Because O'Neil merely discloses URIs and Sakagawa merely discloses a shortcut path message, neither O'Neil nor Sakagawa discloses "predetermined field is a subfield of a user part of said message," "load control information," much less the noted features expressly recited in amended claim 2. Therefore, claim 2 is allowable over O'Neil and Sakagawa, whether taken alone or in combination, and the rejection of claim 2 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Regarding the motivation to combine, Applicants submit that the Examiner's proposed combination, which relies on O'Neil and Sakagawa would impermissibly change the fundamental principle of operation of those references and like lead to an inoperative system. See M.P.E.P. 2143.03("[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959))." See also *Ex Parte Toftness*, 2008 WL 4451384 (Bd. Pat. App. & Int 2008) (reversing the Examiner's section 103 rejection as the proposed combination would

yield an inoperative device). Here, the Examiner inserts Sakagawa's mechanisms operative only to provide a shortcut path into O'Neil's URI based load balancing system, resulting in either a fundamentally changed combination or, more likely, an inoperative system. Indeed, O'Neil would check the server rather than the message, and Sakagawa does not cure that teaching in O'Neil. For this additional reason, the rejection under 35 U.S.C. 103(a) should be withdrawn.

Independent claims 26, 32, 40, 43, and 44 include similar features as noted above with respect to claim 1. Claims 28 and 37 depend from claims 26 and 32 and include all of the features recited therein. For at least the reasons noted above with respect to claim 1, claims 26, 28, 32, 37, 40, 43, and 44 are allowable over O'Neil and Sakagawa, whether taken alone or in combination, and, the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

The Examiner rejected claims 3 and 5 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and Orton. Applicants respectfully traverse this rejection.

Claims 3 and 5 depend from claim 1 and recite all of the features therein. While Orton discloses SIP messages, Orton fails to cure the aforementioned deficiencies of O'Neil and Sakagawa. For at least the reasons given above, claims 3-5 are allowable over O'Neil, Sakagawa, and Orton, whether these references are taken individually or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claim 4 under 35 U.S.C. §103(a) as unpatentable over O'Neil in view of Sakagawa, Orton, and Morrow. Applicants respectfully traverse this rejection.

Claim 4 depends from claim 1. While Morrow discloses INVITE messages, Morrow fails to cure the aforementioned deficiencies of O'Neil, Sakagawa, and Orton. Thus, claim 4 is allowable over O'Neil, Sakagawa, Orton, and Morrow, whether these references are taken individually or in combination, and the rejection of claim 4 under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claims 6-9, 12, 13, and 35 under 35 U.S.C. §103(a) as unpatentable O'Neil, Sakagawa, and Krause. Applicants respectfully traverse this rejection.

Claims 6-9, 12, and 13, depends from claim 1, and claim 35 depends from claim 32. While Krause discloses message headers, Krause fails to cure the aforementioned deficiencies of O'Neil and Sakagawa. For at least the reasons noted above with respect to claims 1 and 32, claims 6-9, 12, 13, and 35 are allowable over O'Neil, Sakagawa, and Krause, whether these references are taken individually or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

Regarding claim 6, it recites “providing a plurality of subfields in said user part for conveying different types of said load control information.” But as noted above, Krause merely discloses a header including, for example, a destination ID, not a “user part” much less “load control information.” Moreover, the Krause header is clearly part of the address, so the ***Examiner has committed a clear error by improperly ignoring*** that claim 1 (from which claim 6 depends) recites that the “wherein the load control information is separate from addressing information for said message.” Thus, the Krause header cannot comprise the alleged feature of claim 6. For this additional reason, claim 6 is allowable over O'Neil, Sakagawa, and Krause, whether these

references are taken individually or in combination, and the rejection of claim 6 under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claims 11, 27, 29-31, 33, 34, and 42 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and Morrow. Applicants respectfully traverse this rejection.

Claim 11 depends from claim 1; claims 27 and 29-31 depend from claim 26; claims 33 and 34 depend from claim 32; and claim 42 depends from claim 40. For at least the reasons noted above with respect O'Neil, Sakagawa, and Morrow, claims 11, 27, 29-31, 33, 34, and 42 are allowable over O'Neil, Sakagawa, and Morrow, whether these references are taken individually or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claims 14, 17, 18, 23, and 38 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and Black. Applicants respectfully traverse this rejection.²

Claims 14 and 17, 18, 23 depend from claim 1; and claims 38 depends from claim 32. While Black discloses that the communication manager "signaling destination address (including the UDP port number) is described in the group's session description," that disclosure has nothing to do with load control information. Therefore, Black does not cure the noted deficiencies of O'Neil and Sakagawa. Therefore, for at least the reasons given above, claims 14, 17, 18, 23, and 38 are allowable over O'Neil, Sakagawa, and Black, whether these references are taken individually or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be

² Only the currently pending claims are listed.

withdrawn.

The Examiner rejected claims 15 and 24 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, Black, and Morrow. Applicants respectfully traverse this rejection.

Claims 15 and 24 depend from claim 1. The Examiner's statements regarding NAT messages on page 38 of the Office Action ignore the express language of claim 1 as well as claims 15 and 24. For at least the reasons noted above, claims 15 and 24 are allowable over O'Neil, Sakagawa, Black, and Morrow, whether these references are taken individually or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claims 25 and 41 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, and Fredericks. Applicants submit that the cancelation of those claims obviates the rejection.

The Examiner rejected claim 36 under 35 U.S.C. §103(a) as unpatentable over O'Neil, Sakagawa, Krause, and Orton. Applicants respectfully traverse this rejection.

Claim 36 depends from claim 32. For at least the reasons noted above, none of the cited references disclose at least the following feature "wherein said apparatus is configured to set into a predetermined field of said message a load control information to select processing resources of said packet data network." Thus, claim 36 is allowable over O'Neil, Sakagawa, Krause, and Orton, whether these references are taken individually or in combination, and the rejection of claim 36 under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected claim 39 under 35 U.S.C. §103(a) as unpatentable over

O'Neil, Sakagawa, Black and Morrow. Applicants respectfully traverse this rejection.


Claim 39 depends from claim 32. For at least the reasons noted above, none of the cited references disclose at least the following feature "wherein said apparatus is configured to set into a predetermined field of said message a load control information to select processing resources of said packet data network." Thus, claim 39 is allowable over O'Neil, Sakagawa, Krause, and Orton, whether these references are taken individually or in combination, and the rejection of claim 39 under 35 U.S.C. §103(a) should be withdrawn.

CONCLUSION

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Applicant is concurrently filing herewith a Petition for a two-month extension of time and Information Disclosure Statement with the requisite fee, authorization for a credit card payment of the filing fee is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-590001US/NC16961US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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